

REMARKS

Claim 6 stands rejected under 35 U.S.C. 102(b) as being anticipated by Weaver (US 2002/0029859). Applicant respectfully disagrees with the examiner's application of 35 U.S.C. 102(b). "A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference." *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671 (Fed. Cir. 1994) (emphasis added). "A claim is anticipated and therefore invalid only when a single prior art reference discloses each and every limitation of the claim." *Glaxo, Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, (Fed. Cir. 1995).

The cited reference does not contain each and every limitation of the claimed invention. The cited reference includes five stress-relief rollers 36, 38, 40, 42 and 44 each of which includes a spring-loaded axle 46, which allows easy configuring of the rollers (paragraph 0024). The purpose of the five stress-relief rollers is to remove the factory-induced stress (curl) from the base sheet to transform a curled stressed sheet back into its original flat condition for quick application onto a flat substrate (paragraph 0025). Each set of rollers is axially aligned on an axle.

The cited reference does not include a guide bar as claimed and disclosed in the present invention. The front guide bar helps keep the film straight as it comes off roll and is directed to the front roller. The guide bar is bowed outwardly to help prevent wrinkles in the film when it is dispensed from the roll. In contrast, an axis is a line or axle about which a rotating body, such as a set of rollers, turns. The five axles and rollers serve to relieve the stress in and remove the curl from the base sheet. The axles and rollers serve a different purpose and would not work if substituted for the guide bar. Additionally, there is no suggestion in Weaver to use a bar or a

curved bar in place of any of the axles and rollers. Accordingly applicant respectfully requests that this rejection is withdrawn.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) sets forth the four steps for establishing a background for determining obviousness and summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The Examiner failed to follow these four steps for establishing a background for determining obviousness.

Prior art for obviousness does not include items in nonanalogous fields. *See In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPS 1979). In *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), the Federal Circuit has applied a two-step test for determining whether a prior art reference is nonanalogous: (1) Is the reference “within the field of the inventor’s endeavor?” and (2) If not, is the reference “reasonably pertinent to the particular problem with which the inventor was involved.”

Claims 1-3 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 3,617,424) in view of Weaver (U.S. 6,484,781) and Hefter et al (US 2003/0101536). Smith does not include a guide bar or a trailing roller as claimed. As discussed above for the published application and as is likewise applicable to Weaver ‘781, the Weaver references do not include a guide bar. The apparatus disclosed in Hefter is a cleaning

device for a moving stairway, and is not for applying film to a carpeted surface. The cited references teach away from the claimed invention and provide no suggestion or motivation for their combination. Additionally, Hefter is not a proper reference under the *Deminski* test.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 3,617,424) in view of Weaver (U.S. 6,484,781) and Hefter et al (US 2003/0101536) further in view of Hughes (U.S. 4,212,611). Smith does not include a guide bar or a trailing roller as claimed. As discussed above for the published application and as is likewise applicable to Weaver '781, the Weaver references do not include a guide bar. The apparatus disclosed in Hefter is a cleaning device for a moving stairway, and is not for applying film to a carpeted surface. The apparatus disclosed in Hughes is an apparatus for forming individual serving portions of a frozen dairy confection. The cited references teach away from the claimed invention and provide no suggestion or motivation for their combination. Additionally, neither Hefter nor Hughes is not a proper reference under the *Deminski* test.

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 3,617,424) in view of Weaver (U.S. 6,484,781). As discussed hereinabove, Smith does not include a guide bar and the Weaver reference does not disclose or suggest the use of a guide bar.

Claims 7-11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 3,617,424) in view of Weaver (U.S. 6,484,781) and Hefter et al (US 2003/0101536). As discussed hereinabove, Smith does not include a guide bar and the Weaver reference does not disclose or suggest the use of a guide bar and Hefter is nonanalogous prior art. Additionally, Hefter discloses a structure for supporting the device when it is traveling up the moving staircase, and not for supporting the device over a staircase (see Figs. 7 and 8).

Further, with respect to claim 13, the examiner fails to explain how the structure cited in Hefter which includes a radius, may be used to tuck the film into a 90 degree corner of the stairs.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 3,617,424) in view of Weaver (U.S. 6,484,781) and Hefter et al (US 2003/0101536) and further in view of Kudicka (U.S. 4,462,627). As discussed hereinabove, Smith does not include a guide bar and the Weaver reference does not disclose or suggest the use of a guide bar and Hefter is nonanalogous prior art. Further, Kudicka is directed to a lift frame assembly and is not a proper reference under the *Deminski* test.

The mere fact that one can selectively combine elements of these devices, or use a concept from one as a basis for developing novel improvements on another, does not show a prima facie case of obviousness. Such a showing is found in most inventions which are, after all, improvements on existing technology.

The Federal Circuit itself has found that virtually all inventions are combinations of old elements. See *In re Rouffet*, 149 F.3d at 1357.

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

Id. (quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed.Cir.1996)).

It is often the case that every element of an invention can be found in the prior art. If patentability could be refused merely by demonstrating that each element of an invention is found in the prior art, then very few patents would be granted. At most the Examiner has culled elements from disparate references to combine in a manner only disclosed and suggested by the application under review. For example, transistors, resistors and capacitors are known in the art, yet the combination of these discrete elements in a single integrated circuit to form a microprocessor has not been found to be obvious.

Describing in detail the similarities between the “references and the claimed invention, noting that one reference or the other—in combination with each other ... described all of the limitations of the pending claims” is not sufficient evidence to support a finding of obviousness. *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614 (Fed. Cir. 1999). The Examiner must identify a suggestion, teaching, or motivation to combine these references including “identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.” *Id.* Simply stating that the references would have suggested the combination is insufficient. *See id.*

Even if the Examiner has shown evidence that it would have been obvious to one skilled in the art to try combining the device in Smith with the devices in the other cited references, “this is not the standard of 35 U.S.C. § 103.” *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). While prior art references may provide a means to combine, or examples of related

combinations, if they do not suggest the advantages gained by the combination of the claimed invention they do not provide a motivation to combine. “A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.” *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). The references must teach the advantage in order to suggest or motivate, not just the possibility of combination or the suggestion to try. The Federal Circuit “has consistently refused to recognize ‘obvious to try’ rejections.” *In re Goodwin*, 576 F.2d 375, 377 (CCPA 1978).

The proper question is whether the Examiner found a suggestion or motivation to combine specific elements of the prior art to yield the present invention. The Examiner has provided no evidence of a suggestion to combine the cited references to result in the present invention. “No prior art provided a teaching or suggestion or motivation that a [device] should be made with the structure shown and claimed” in the instant application. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225 (Fed. Cir. 1998). Absent this essential component of a prima facie case of obviousness, the Examiner’s rejection should be withdrawn. *See id.*

The Examiner cannot use the invention to render itself obvious. “The invention that was made, however, does not make itself obvious; that suggestion or teaching must come from the prior art.” *C.R. Bard*, 157 F.3d at 1352. The Examiner essentially lists the claim limitations and matches them with elements from the cited references. “It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion or incentive to make the combination made by the inventor.” *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).

No rationale is provided other than that disclosed in the application itself. The Examiner has combined the cited references, “using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The Examiner essentially states that it would have been obvious for one skilled in the art at the time the invention was made to do exactly what the inventor did for exactly the reasons disclosed in the application. “The absence of a convincing discussion of the specific sources of the motivation to combine the prior art references . . . is a critical omission in [an] obviousness analysis.” *Ecolochem, Inc. v. Southern California Edison Company*, 227 F.3d 1361, 1374, 56 USPQ2d 1065 (Fed. Cir. 2000). “[A] rejection cannot be predicated on the mere identification . . . of individual components of claim limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed.” *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

“The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination.” MPEP, 7th Edition (1998), § 2143.01, p. 2100-112 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Nowhere does the Examiner particularly identify any suggestion, teaching or motivation to combine the prior art references to achieve the present invention. “Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome

wherein that which only the inventor taught is used against its teacher.”“ *In re Dembiczak*, 175 F.3d at 999 (quoting *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)).

The prior art must be considered in its entirety, including disclosures that teach away from the claims. It is error to find obviousness where references “diverge from and teach away from the invention at hand.” *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994).

A compelling argument to rebut an assertion prima facie obviousness through a combination of references “is the contention that those references together teach away from their combination.” *McGinley v. Franklin Sports, Inc.*, 2001 WL 939088, * 8 (Fed. Cir. August 21, 2001) (citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994)). Upon reading Smith and Weaver, one would be led to further developments in combining the structure of Smith with the axles and rollers in Weaver. Nothing in Smith suggests or motivates providing a bowed guide bar. Upon reading Weaver, whatever motivations may occur to the reader are not directed by the disclosure to the film applicator as claimed. Neither reference suggests modifications that would lead to the claimed invention, and neither reference suggests a path that would lead to their combination. “[R]eferences that teach away cannot serve to create a prima facie case of obviousness.” *McGinley*, 2001 WL 939088, *11.

The statutory standard for the determination of obviousness provides that a claimed invention is unpatentable “if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (emphasis added). Case law provides that “[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (emphasis added). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be “clear and particular,” and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” *See In re Dembiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617.

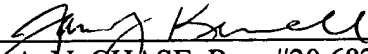
The Examiner has pulled several references from the prior art including Hughes (4,212,611) and Kudlicka (4,462,627) but has failed to address the invention as a whole. The carpet film applicator of the present invention provides a unique apparatus that was not obvious in view of the prior art, even if the individual elements used to comprise it were readily available, which the applicant respectfully denies that that the individual elements are in the prior art cited. “As a whole” the device was not obvious at the time of invention. The ultimate determination of obviousness should be based on the totality of the evidence, not a culling of elements pulled from disparate references to combine in a manner only disclosed and suggested by the application under review. *See In re Dembiczak*, 175 F.3d 994 generally and *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1131, 56 USPQ2d 1456 (Fed. Cir. 2000).

The apparatus of the present invention provides a carpet film applicator in a form and with the additional elements not provided or disclosed in the prior art. A claimed invention as a whole must be considered. “[I]t is this invention as a whole, and not some part of it, which must be obvious under 35 U.S.C. § 103.” *In re Antonie* at 619. Discovering the source or cause of a problem is part of the “as a whole” requirement. MPEP, § 2141.02, p. 2100-108. “A patentable invention may lie in the discovery of the source of the problems even though the remedy may be obvious once the source of the problem is identified.” MPEP, § 2141.02, p. 2100-108 (quoting *In re Spinnable*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969)). The devices disclosed in Smith, Weaver, Hefter, Hughes, and Kudlicka do not solve the problem of the applying a wrinkle free film to a carpeted surface, especially stairs. The applicants discovered the source of the problem, namely that the film will wrinkle as it is dispensed from the roll and is not suited for smooth application on stairs. If discovery of the source was not obvious, then the invention can not be obvious, even if the remedy is once the source is identified.

As discussed in detail hereinabove, applicant believes that the Examiner’s obviousness rejection should be withdrawn as applied to the claims 1 and 6 and accordingly to all claims depending therefrom. Additionally, application believes that the Examiner’s rejection under 35 U.S.C. § 102 should also be withdrawn, as discussed in detail hereinabove.

Accordingly, applicant respectfully requests that this application be passed to allowance.

Respectfully submitted,


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